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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/270,710
Filing Date: March 16, 1999
Appellant(s): GLASER, LAWRENCE F.

Donald R. Studebaker, Reg. No. 32,815
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/8/06 appealing from the Office action
mailed 4/1/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,018,761	UOMINI	1-2000
6,029,141	BEZOS et al	2-2000
WO96/24213	GOLDSCHMIDTT et al	8-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-19 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96124213 A1, Goldschmitt et al. (hereinafter Goldschmitt) in view of Bezos et al., Pat. No. 6,029,141 (hereinafter Bezos).

As per claim 1, Goldschmitt discloses a method of transmitting an advertisement from a sending party to a receiving party (see abstract and Fig. 4) comprising the steps of:

- initiating a communication from a data processing system of the sending party (see Fig. 1 and page 8, line 26 - page 9, line 2);
- transmitting said communication with said at least one advertisement therein to the recipient (see abstract)

Goldschmitt does not explicitly disclose:

- embedding the advertisement within the communication.

- associating the preselected advertisement with said communication within the user-managed data processing system

However, Bezos discloses embedding the advertisement within the communication and associating the preselected advertisement with said communication within the user-managed data processing system (i.e. can disseminate catalogs ... e mail newsletters ... that include the associate's reviews and/or recommendations on specific products sold by the merchant)(col. 1, lines 56-61 and col. 8, line 59 - col. 9, line 8). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Bezos within Goldschmitt for the motivation of efficiently marketing and selling goods (col. 1, lines 50-55).

As per claim 2, Goldschmitt discloses the method of claim 1, further comprising the steps of: offering to the sender an option of becoming an advertiser (i.e. offer to provide free email service) and enabling, if the offer is accepted, a procedure within said user managed data processing system by which said preselected advertisement is associated with the communication (see abstract).

As per claim 3, Bezos and Goldschmitt do not explicitly disclose the method of claim 1, wherein the advertisement related to at least one of software or hardware operable with the user managed data processing system. However, the Examiner takes official notice that it was well known in the advertising arts to provide advertisements that are directed to software or hardware operable on data processing systems. The motivation for software and hardware advertisements was to draw a user's attention to

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products that a computer user would be interested in. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation within Goldschmitt and Bezos for the motivation stated above.

As per claim 4, Goldschmitt discloses the method of claim 1, wherein the communication is at least one of e-mail, facsimile, voice-over-IP, voice-over-Internet, voice mail, video mail, video teleconferencing, and an animated presentation (i.e. email)(see abstract).

As per claim 5, Goldschmitt discloses the method of claim 1, wherein the advertisement is sent for a preselected time period (i.e. between 5:00 PM and 7:00 PM)(page 6, lines 1-11.)

As per claim 6, Goldschmitt discloses the method of claim 1, wherein the advertisement is sent up to a pre-selected number of times (i.e. certain number of times during the day)(page 6, lines 1-11).

As per claim 7, Goldschmitt discloses the method of claim 1, wherein said preselected advertisement is electronically obtained from a third party data processing system (i.e. advertiser storage data files unit 24)(see Fig. 1 and page 8, lines 14-15).

As per claim 8, Goldschmitt discloses the method of claim 2, wherein the user is compensated for accepting the offer to become an advertiser (i.e. user receives free email)(see abstract).

As per claim 9, Goldschmitt discloses the method of claim 1, wherein the advertisement is at least one of visual and aural (i.e. graphics)(page 9, lines 23-29).

As per claim 10, Goldschmitt does not explicitly disclose the method of claim 2, wherein the advertisement is incorporated in setup software for one of software and hardware on said user managed data processing system. However, the Examiner takes official notice that it was well known to provide advertisements within setup software for software or hardware in the computer arts. The purpose was to alert the customer of other products owned by the manufacturer that might be of interest to the customer. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 2, wherein the advertisement is incorporated in setup software for one of software and hardware within the Goldschmitt system for the motivation stated above.

As per claim 11, Goldschmitt discloses the method of claim 2, wherein means for sending the communication comprises at least one of an e-mail client, a facsimile system, a voice-over-IP system, a voice-over-Internet system, a voice mail system, a video mail client, and a video conferencing system (i.e. email)(see abstract).

As per claim 12, Goldschmitt discloses the method of claim 2, further comprising offering to a recipient of the communication and advertisement an option of being an advertiser (see abstract).

As per claim 13, Goldschmitt discloses the method of claim 12, wherein said step of offering to a recipient of the communication and advertisement an option of being an advertiser includes fraud avoidance means for reducing or eliminating fraud associated with the transaction (see abstract).

As per claim 14, Goldschmitt discloses the method of claim 7, wherein said preselected advertisement is electronically obtained from a third party data processing system using the Internet (page 8, lines 5-8).

As per claim 15, Goldschmitt discloses the method of claim 1, wherein the advertisement is displayed to a recipient during a period of at least one of before, during and after the communication (page 8, lines 10-13 and page 9, lines 1-7).

As per claim 16, Goldschmitt discloses the method of claim 1, wherein the user managed data processing system is at least one of a computer and telephone (see Fig. 1 and col. 8, lines 1-13).

As per claim 17, Goldschmitt discloses the method of claim 2, wherein the advertisement is embedded in the communication by a third party (i.e. email messaging center 18)(page 8, lines 14-25).

As per claim 18, Goldschmitt discloses the method of claim 1 wherein said preselected advertisement is determined at least in part by the recipient's demographic (i.e. profile match information identifying certain demographic information)(page 8, lines 14-25).

As per claim 19, Goldschmitt discloses the method of claim 18 wherein said demographic is at least one of location, language, gender, age, income, and physical handicap (i.e. profile match information identifying certain demographic information) (page 8, lines 14-25).

As per claim 23, Goldschmitt discloses the method of claim 1. Goldschmitt does not explicitly disclose wherein the pre-selected advertisement is under the local control of the sending party. However, Bezos discloses the pre-selected advertisement is under the local control of the sending party (i.e. unit 120)(see Fig. 1 and col. 6, lines 59-67). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed in Bezos within Goldschmitt for the motivation stated above for claim 1.

As per claim 24, the claim is substantially similar in scope to claim 23 and is rejected on the same basis.

As per claim 25, Goldschmitt does not explicitly disclose the method of claim wherein said at least one advertisement includes a hyperlink. However, Bezos discloses said at least one advertisement optionally includes a hyperlink (Fig. 6, unit 600). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Bezos within Goldschmitt for the motivation of efficiently marketing and selling goods (col. 1, lines 50-55).

3. ¹Claims 20-21 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldschmitt in view of Bezos and Uomini, Pat. No. 6,018,761.

¹ The heading corrects a typographical error included in the Office Action mailed 4/1/05, whereby claim 26 was unintentionally listed with the incorrect independent claim. The rationale of the rejection for claim 26 has not been altered.

As per claim 20, Goldschmitt discloses a method of transmitting an electronic communication including an advertisement from a user managed data processing system associated with a sending party to a data processing system associated with a receiving party (see abstract) comprising the steps of:

- transmitting an electronic communication using the data processing system associated with the sending party to the data processing system associated with the recipient (see abstract).

Goldschmitt does not explicitly disclose

- embedding the advertisement within the communication.
- associating the preselected advertisement with said communication within the user-managed data processing system wherein said at least one advertisement optionally includes a hyperlink.

However, Bezos discloses embedding the advertisement within the communication and associating the preselected advertisement with said communication within the user-managed data processing system (i.e. can disseminate catalogs ... email newsletters ... that include the associate's reviews and/or recommendations on specific products sold by the merchant)(col. 1, lines 56-61 and Col. 8, line 59 - col. 9, line 8) wherein said at least one advertisement optionally includes a hyperlink (Fig. 6, unit 600). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Bezos within Goldschmitt for the motivation of efficiently marketing and selling goods (col. 1, lines 50-55).

Goldschmitt and Bezos do not explicitly disclose:

- locating a data file containing signature information on the data processing system associated with the sending party, said signature information being appended to electronic communications originating from the user managed data processing system associated with the sending party;
- modifying information stored within said signature file to include an advertisement; and
- said electronic communication including said information stored within said signature file including said advertisement.

However, Uomini discloses an electronic messaging system that attaches information to the mail messages (see abstract and cot. 1, lines 8-10). A signature block (i.e. context data) is used to transmit information to the recipient and is attached to the sender's message (see Col. 5, lines 6-18). Furthermore, Uomini discloses the signature block may contain business information (i.e. advertisement)(col. 5, lines 10-12). The motivation for including an advertisement within the signature block was to attach information to the mail message (cot. 1, lines 8-10 and cot. 3, lines 1-5). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include locating a data file containing signature information on the data processing system associated with the sending party, said signature information being appended to electronic communications originating from the data processing system associated with the sending party, modifying information stored within said signature file to include an

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advertisement and said electronic communication including said information stored within said signature file including said advertisement as disclosed by Uomini within the Goldschmitt and Bezos system for the motivation stated above.

As per claim 21, Goldschmitt, Bezos, Uomini do not explicitly disclose the method of claim 20 wherein said signature file is associated with an e-mail client operating on said user managed data processing system associated with the sending party. The Examiner takes official notice that it was well known in the computer arts to use signature files within user managed data processing systems. The motivation for embedding the advertisements with in a signature file at the third party data processing system allows the system to add advertisements to the portion of the email message that is always present thereby simplifying the efficiency and cost of the system. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 20 wherein said signature file is associated with an email client operating on said data processing system associated with the sending party within the Goldschmitt system for the motivation stated above.

As per claim 26, the claim is substantially similar in scope to claim 25 and is rejected on the same basis.

4. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldschmitt and Bezos as applied to claim 1 above, and further in view of Uomini.

As per claim 22, Goldschmitt and Bezos do not explicitly disclose the method of claim 1 where associating said preselected advertisement with said communication further comprises associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement.

However, Uomini discloses associating said preselected advertisement with said communication further comprises associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement (see Fig. 2b and 2c). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the method of claim 1 where associating said preselected advertisement with said communication further comprises associating a personal testimonial by said sending party thereby lending credibility to said preselected advertisement within the Goldschmitt and Bezos combination for the motivation of obtaining message context information for the recipient regardless of whether it is provided or not by the sender (col. 1, lines 8-10 and col. 2, lines 56-67).

(10) Response to Argument

(A) As an initial matter, the Examiner never indicated that any limitation or claims in any pending or previously pending form were in allowable condition, as suggested by the Appellant on page 10 of the 3/8/06 Appeal Brief. At best, Appellant and Examiner

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discussed specific teachings of the Bezos reference but the Examiner never objected to claimed features or indicated that a particular feature was allowable. See Interview Summary dated 3/30/04.

(B) Applicant argues that in contrast to Bezos, the claimed invention clearly distinguishes a communication from an advertisement.

In response, the Examiner respectfully disagrees. In Fig. 6 of Bezos, the recommendation/endorsement/review as represented by unit 606 could represent an advertisement authored by the affiliate (i.e. sender). Furthermore, the graphic icon unit 600 that represents the book that is the subject of the review represents another advertisement for the book. Finally, Figure 6 contains a hyperlink unit 608 for the book (the Examiner notes that the hyperlink includes the name of the book and alerts user that this hyperlink is to be "clicked in order to purchase the book). Fig. 6 represents the communication or part of a communication sent from the affiliate (i.e. sender) to the customer (i.e. recipient). Bezos discloses that a catalog (i.e. communication) can be disseminated by multiple dissemination techniques including email (col. 9, lines 1-8).

The e-mailed catalogs include embedded advertisements and the catalogs are transmitted from the sending party to the receiving party (see Fig. 6 and Fig. 10). All these features are under local control of the sending party (see Fig. 1, unit 120 and col. 6, lines 59-67) since the documents are found in local storage on the associate's server. The associate (i.e. sending party) can freely modify the product descriptions and the referral links (col. 9, lines 1-8). Clearly, the advertisement is under control of the sending

party (i.e. the affiliate) and the referral link is under control of the sending party (i.e. affiliate). Therefore, Bezos discloses embedding the advertisement within the communication and associating the preselected advertisement with said communication within the user-managed data processing system.

(C) Appellant also presents arguments regarding the Examiner's interpretation of the term advertisement.

It should be noted that the Applicant's specification does not contain any definition of the term advertisement. The specification broadly describes an advertisement as:

including an animated display (i.e. banner, icon, sprite) or could include a novelty or game ***that is designed to attract the attention of the recipient***. Thus, as will be understood, ***the present invention is not directed to the specific form and content of the advertisement***. In one preferred embodiment, the advertisement includes a hyperlink to another resource of information, such a link to the World Wide Web as shown in Figure 1. (***Emphasis added***) (Page 11, lines 15-20)

Moreover, exemplary Figure 1 of the Applicant's specification includes an e-mail communication with a hyperlink.

The Examiner relied on the definition of advertisement as shown in the Merriam Webster's Collegiate Dictionary. Clearly, the act of calling something to the attention of the public could be encompassed by printed materials which contain graphics (i.e. a picture, a company name or a logo) and/or text (i.e. the product name or company name or some description). In this context, even the card of Uomini qualifies as an advertisement.

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(D) Appellant further argues that there is no motivation to combine Goldschmidt and Bezos.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner cited motivation to combine directly from the references.

Moreover, as to applicant's argument that Goldschmidt and Bezos references cannot be combined, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Bezos was used to show that the advertisements embedded within communications (i.e. email) are within the control of the sending party.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Rachel L. Porter

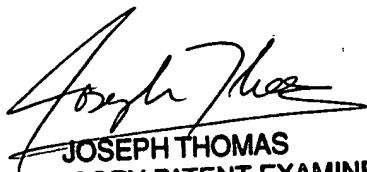
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